

REMARKS

Claims 50-103 are presently pending. Claims 1-49 were canceled previously. The Examiner has indicated that claims 54, 67, 79, and 93 would be allowable if rewritten to include all of the limitations of the claims from which they depend.

Applicants respectfully request reconsideration of the application in view of the remarks appearing below, which Applicants believe show that all presently pending claims are in condition for allowance.

Rejection under 35 U.S.C. § 102

The Examiner has rejected claims 98 and 101 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,298,327 to Hunter et al., stating that Hunter et al. disclose all of the limitations of these claims. Applicants respectfully disagree.

Generally, the Hunter et al. patent is directed to an expert system that aids inventors, technology managers, and patent professionals in authoring invention disclosures, including patent applications, and in evaluating the probable patentability and marketability of a disclosed invention.

In rejecting claims 98 and 101, the Office Action sets forth for each of the various limitations of the claims a number of pinpoint citations to locations in the Hunter et al. patent where parts of that limitation are assertedly disclosed by Hunter et al. Importantly (for reasons discussed below), these pinpoint citations point to locations scattered throughout the Hunter et al. patent. Indeed, the subject matter disclosed at the pinpointed locations are just as disparate as the citations themselves. This is not surprising, however, because Hunter et al. do not disclose or so much as suggest a method of analyzing a group of patents to which claims 98 and 101 are directed. Applicants assert that the present rejection of claims 98 and 101 is not proper for at least the following two reasons: 1) the rejection does not take into account the effect of the preambles of these claims and 2) the rejection does not properly consider the claimed invention as a whole.

Regarding the first reason, the MPEP clearly states that statements made in the preamble of a claim "must be evaluated to determine whether the recited purpose or intended use [recited

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in the preamble] results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim.” MPEP § 2111.02 (emphasis added). In the present case, the preamble of claim 98 recites that the claim is directed to a method “of analyzing a group of documents” that includes the various steps recited in the body of claim 98. (It is noted that the effect of the preamble of claim 101 is similar to the effect of the preamble of claim 98, even though it is in Beauregard format.)

To illustrate how the Office Action fails to properly treat the preamble as important to the claim, in rejecting claim 98, the Office Action parses the claim limitation of “reviewing each of said plurality of patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents” into the following three phrases: 1) “retrieving a plurality of patent documents from a first database;” 2) “so as to determine for each of said plurality of patent documents;” and 3) “a problem solved by said at least one invention corresponding to that one of said plurality of patent documents.” Office Action, pp. 2-3. The Office Action then states that Hunter et al.: disclose the subject matter of the first phrase at col. 17, lines 50-52 and col. 1, lines 16-20; disclose the subject matter of the second phrase at col. 13, lines 28-30 and col. 1, lines 16-20; and disclose the subject matter of the third phrase at col. 15, lines 34-40, col. 19, lines 59-61, col. 16 lines 17-21, and col. 1, lines 16-20.

First, Applicants point out that the citation to col. 1, lines 16-20 appears completely nonsensical in the context of the three phrases. Col. 1, lines 16-20 of the Hunter et al. patent read in their entirety: “The copyright owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure as it appears in the Patent and Trademark Office patent files or records, but otherwise reserves all copyrights whatsoever.” Applicants fail to see how this statement regarding copyrights in the Hunter et al. patent disclosure discloses or suggests any one of the three above-quoted phrases, let alone all of them. Discounting, then, the citations to col. 1, lines 16-20, the remaining pinpoint citations are directed to aspects of the Hunter et al. expert system that are unrelated to one another and that certainly do not disclose or suggest, separately or together, the limitation of claim 98 of “reviewing each of said plurality of

patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents.”

Consequently, in the context of the three parsed phrases of claim 98 quoted above, the preamble of claim 98 indeed provides a “manipulative difference” between the claim limitation in its proper entirety, i.e., “reviewing each of said plurality of patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents,” and the three wholly unrelated aspects of the Hunter et al. expert system that the Office Action asserts discloses this limitation. Essentially, this manipulative difference is that the just-quoted limitation must be examined as a whole, rather than being parsed into arbitrary component parts. Since the preamble indeed provides a manipulative difference between claim 98 and the Hunter et al. patent, as MPEP § 2111.02 counsels, the preamble of claim 98 is indeed a limitation of the claim. When each of claims 98 and 101 are considered in light of their preambles, i.e., each of the limitations of these claims are examined without improperly parsing the limitations, it is clear that the Office Action’s rejection of these claims that simply grafts together unrelated concepts in attempt to reconstruct individual claim limitations is improper.

As mentioned above, the present rejection is also improper because the Office Action has failed to consider the claimed invention as a whole, as taught by MPEP § 2141.02. When members of the U.S. Patent and Trademark Office’s examining corps examine claims, they must consider each claimed invention as a whole. One result of this is that the examining corps must find teachings in the references it applies in rejecting claims that address each and every limitation of the claims. Each claim limitation must be found either in its entirety or as a logical, coherent combination of parts.

In the present case, relative to claim 98, the examining corps must find a reference that teaches in a coherent exposition the step of “reviewing each of said plurality of patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents.” It should be manifestly evident that this limitation cannot logically be parsed into components. For example,

the phrase of this limitation "so as to" means that the part appearing after this phrase, i.e., "determine . . . a problem solved" is an immediate result of the part appearing before the phrase, i.e., "reviewing each of said plurality of patent documents." Consequently, to parse this coherent limitation into multiple parts, to find disparate support for these parts, and to reconstruct the entire limitation from such disparate support is not only a violation of proper examining procedures as set forth in the MPEP and U.S. case law, but it is nonsensical. To illustrate how this is nonsensical, the approach of systematically parsing limitations in the manner of the present Office Action can be taken to the absurd extreme by parsing each limitation into individual words and asserting that the claim is anticipated by a dictionary because each of the words is found in that dictionary, even though the words are unrelated and out of context relative to any of the limitations and the claim as a whole. The present rejection, of course, does not go that far. Nevertheless, the parsing approach used in the rejection bears some relation to this extreme example.

Because the present anticipation rejection is improper for at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the present rejection of claims 98 and 101. If the Examiner continues the rejection, Applicants respectfully request that the Examiner address how the rejection takes into consideration the preamble of the claims and the claims as a whole. In particular, Applicants request that the Examiner address how it is proper to assert that a reference teaches a claim limitation when the asserted limitation is merely an incongruous reconstruction of disparate subject matter taken from multiple locations and out of multiple contexts that are not only disparate from each other but are also unrelated to the context of the claim limitation.

Rejections under 35 U.S.C. § 103

**The Continued Dunworth et al./Liddy et al., Dunworth et al./Liddy et al./Chen et al.,
Dunworth et al./Liddy et al./Bollay, and Dunworth et al./Liddy et al./Chen et al./Bollay
Rejections**

The Examiner continues to reject claims 50, 51, 55-57, 63, 64, 68-70, 75, 76, 80-82, 87-89 and 93-95 (independent claims underlined for convenience) under 35 U.S.C. § 103 as being obvious in view of U.S. Patent No. 5,930,474 to Dunworth et al. and U.S. Patent No. 5,873,056

to Liddy et al., stating Dunworth et al. disclose a method, computer readable medium and system containing all of the limitations of these claims except for certain features, e.g., extracting user-defined fields values, filtering a plurality of retrieved documents so as to obtain a refined set of documents, and associating weights with at least some user-defined fields. The Examiner then asserts that Liddy et al. disclose these limitations and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Liddy et al. in the method, computer readable medium and system disclosed by Dunworth et al. Applicants respectfully disagree.

The Examiner also continues to reject claims 52, 53, 65, 66, 77, 78, 90, and 91 under 35 U.S.C. § 103 as being obvious in view of the Dunworth et al. and Liddy et al. patents, discussed above, and further in view of U.S. Patent No. 6,728,752 to Chen et al., stating Dunworth et al. and Liddy et al. disclose a method, computer readable medium and system containing all of the limitations of these claims except for limitations directed to a high-level of abstraction (HLA) cluster and an HLA framework form. The Examiner then asserts that Chen et al. disclose these limitations and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Chen et al. in the method, computer readable medium and system disclosed by the combination of the Dunworth et al and Liddy et al. patents. Applicants respectfully disagree.

In addition, the Examiner continues to reject claims 58, 60-62, 71-74, 83-86, 96 and 97 under 35 U.S.C. § 103 as being obvious in view of the Dunworth et al. and Liddy et al. patents, discussed above, and further in view of U.S. Patent No. 6,457,009 to Bollay, stating Dunworth et al. and Liddy et al. disclose a method, computer readable medium and system containing all of the limitations of these claims except for limitations directed to the population of user input forms. The Examiner then asserts that Bollay discloses these limitations and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Bollay in the method, computer readable medium and system disclosed by the combination of the Dunworth et al and Liddy et al. patents. Applicants respectfully disagree.

The Examiner also continues to reject claim 59 under 35 U.S.C. § 103 as being obvious in view of the Dunworth et al., Liddy et al., Chen et al. and Bollay patents, discussed above, stating Dunworth et al. and Liddy et al. disclose a method, computer readable medium and system containing all of the limitations of these claims except for limitations directed to the population of user input forms. The Examiner then asserts that Bollay discloses these limitations and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Bollay in the method, computer readable medium and system disclosed by the combination of the Dunworth et al. and Liddy et al. patents. Applicants respectfully disagree.

Reply to Examiner's Rebuttal of Applicants' Arguments of the 5/11/05 Office Action

Applicants reiterate their arguments appearing in the prior Response filed with the U.S. Patent and Trademark Office on May 11, 2005, in their entireties. Prior to addressing the rejections in detail, Applicants assert that with all of the obviousness type rejections herein, the examining corps, like with the anticipation rejection discussed above, has failed to take into account the claims as a whole as well as their preambles, in addition to failing to consider each of the cited references as a whole, including the lack of motivation to make the combinations.

Applicants address immediately below each of the Examiner's itemized rebuttals to Applicants arguments set forth in their Response of May 11, 2005. The item numbers in the following sections refer to the numbered sections of the present Office Action.

Office Action Item 31

In numbered item 31 of the present Office Action that is directed to independent claims 50, 63, 75, and 87, the Examiner asserts in rebuttal to Applicants' arguments that the words "cause" and "generate" are interchangeable with the word "develop," which Applicants assert has the meaning in the context of claim 50 of "to arise and then increase or progress to a more developed state." 5/11/05 Response, p. 14, lines 7-8. Applicants respectfully disagree.

The limitation at issue in item 31 is "developing a set of search arguments relating to one or more interests of a user." [Emphasis added.] The Examiner asserts that Dunworth et al. teach this limitation because the Dunworth et al. Web organizer "translates" a menu selection into either a set of search engine queries or a set of Web destinations. It appears the Examiner is

using the word “causing” in place of the claim word “developing” based on the (false) justification that a thesaurus cites these words as being synonyms. Applicants respectfully disagree with this substitution.

The Examiner is respectfully reminded that in construing claim terminology, the U.S. Patent and Trademark Office affords claim terminology its broadest reasonable interpretation that is “consistent with the interpretation that those skilled in the art would reach.” MPEP § 2111 (*citing In re Cartright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)). Thus, an examiner is not free to simply apply the broadest interpretation of claim terminology, but rather the examiner must adjust the breadth of the terminology to the breadth that those skilled in the art would give the terminology “taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in the applicant’s specification.” *Id.* (*citing In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) [emphasis added]).

In the present case, it is Applicants’ position that those skilled in the art, having reviewed and understood the present application, would recognize that the word “developing” does not mean “causing,” but rather has a meaning more akin to the definition cited by Applicants. This is so because the present application describes at page 8 *et seq.* that the developing of search arguments flows from a user using an input form to define search arguments. This description does not describe the developing in terms of causation, but rather in terms of transforming from an undeveloped state to a developed state. This is a much different concept than mere causation. Again, Dunworth et al. do not disclose or suggest “developing a set of search arguments” as required by claim 50. [Emphasis added.] Regarding the use of a thesaurus to support the Examiner’s substitution, dictionaries and thesauruses cannot be used in a manner that ignores the meaning that would be ascribed by those skilled in the art.

Office Action Item 32

In item 32 of the present Office Action, the Examiner asserts that Dunworth et al. do indeed disclose “user-defined fields” as required by claims 50, 63, 75, and 87. In particular, the Examiner states that Dunworth et al. teach that while their Web organizer is described as having standard fields, other fields could be defined by each publisher as called for by a particular

application. The Examiner then asserts that a publisher may be considered a user so that the other fields are "user-defined" fields. Applicants respectfully disagree.

Claim 50, for example, requires the steps of "developing a set of search arguments relating to one or more interests of a user" and "developing a set of user-defined fields relating to said one or more interests." [Emphasis added.] In these steps, it is clear to those skilled in the art that the user in the first quoted phrase is the one having one or more interests and is also the one that defines the "user-defined" fields. [Emphasis added.] This is the only reasonable interpretation of the two above-quoted steps of claim 50.

In contrast, in the Dunworth et al. Web organizer, it would be the end-users that have the one or more interests, yet it is the publisher that defines the fields. In other words, Dunworth et al. disclose two different types of users, i.e., end-users and publisher-users. The result is that Dunworth et al. do not disclose "user-defined" fields as contemplated by claim 50. In claim 50, a user-defined field is one that the user having the one or more interests defines. Dunworth et al. are completely silent on providing its end-users with any user-defined fields. Rather, the Dunworth et al. fields are publisher-defined fields. This distinction cannot be ignored in rejecting the present claims, since the claims are explicit on the point that the user-defined fields correspond to the same users that have the one or more interests. Therefore, Dunworth et al. are completely silent on the limitation of "developing a set of user-defined fields" as required by claims 50, 63, 75, and 87.

Office Action Item 33

In item 33 of the present Office Action, the Examiner asserts that Dunworth et al. disclose "user-defined field values" and extracting user-defined values as required by claims 50, 63, 75, and 87. In particular, the Examiner states that Dunworth et al. states that by the publisher entering "YP:SCHOOL" or the like, these entries are "user-defined values." Further, the Examiner asserts that Liddy et al. and Dunworth et al. together teach the limitation of "extracting a user-defined field value." Applicants respectfully disagree.

Regarding the former issue, as discussed above relative to item 32, the publisher-defined fields are not equivalent to the user-defined fields of the present claims. Consequently, field

values input by a publisher are not user-defined field values as contemplated by the present claims.

Regarding the latter issue, Applicants again assert that the examining corps is improperly parsing limitations into phrases without regard to the claimed invention as a whole and without regard to the context-imparting preamble. That is, the examining corps is improperly back-fitting (of course using an improper amount of hindsight of the present claims) a number of unrelated concepts to reject an entire limitation. Again, this is as nonsensical as rejecting the claims based on a dictionary because the dictionary contains all of the words in the claims. (Since this is an obviousness-type rejection, the more appropriate analogy would be to reject the claims based on two or more dictionaries that together contain all of the words of the claims.)

Upon reviewing the references as a whole, it is clear that the combination does not disclose or suggest the entire limitation of claim 50 of "reading each of said plurality of retrieved documents from among the plurality of documents so as to extract from each of said plurality of retrieved documents a user-defined fields value" in the context of "researching and analyzing information contained in a plurality of documents belonging to a first database, searchable on a plurality of search fields and having a plurality of search field values" as required by the preamble of claim 50.

Office Action Item 34

In item 34 of the present Office Action directed to independent claims 50, 63, 75, and 87, the Examiner asserts in rebuttal to Applicants' arguments that the Dunworth et al. Web organizer is a user-modifiable navigation tool and that claims 50, 63, 75, and 87 do not address the issue of populating databases. Applicants respectfully disagree.

Regarding the first issue, the Dunworth et al. Web organizer is not user-modifiable in the sense contemplated by the claims and the sense that would be understood by those skilled in the art. As discussed above, "user-modifiable" in the context of the present claims means that the end-user of the Dunworth et al. organizer would be able to modify the organizer. This simply is not true. Publishers are not end-users. (See the discussion above regarding item 32.) Rather, publishers set up the organizer for use by end-users. Regarding the second issue, clearly claims 50, 63, 75, and 87 include the steps of "entering said plurality of user-defined values" and

“entering the ones of the plurality of search field values” into a second database, which are directed to populating a database. In this connection, the Examiner asserts that claims 58-62 are directed to populating databases. This, too, is not so. Claims 58-62 are directed to populating input forms. Here, too, the examining corps is improperly picking and choosing excerpts from references without any regard to the claimed invention as a whole and to the limiting function of the preamble.

Office Action Items 35, 36, and 38

In items 35 and 36 of the present Office Action the Examiner states that claims 51, 64, 76, and 89 and claims 55, 56, 68, 69, 80, 81, 93, and 94 are obvious. Applicants respectfully disagree.

For the reasons discussed above relative to claims 50, 63, 75, and 87, claims 50, 63, 75, and 87 are not obvious. Therefore, claims 51, 55, 56, 64, 68, 69, 76, 80, 81, 89, 93, and 94 are not obvious. In addition, claims 55, 56, 68, 69, 80, 81, 93, and 94 are not obvious because neither the Dunworth et al. nor Liddy et al. patents disclose or suggest user-defined fields, nor weights associated with such fields.

Office Action Item 37

In item 37 of the present Office Action the Examiner states that Liddy et al. disclose the limitation of claims 57, 70, 82, and 95 of tallying weights associated with user-defined fields, thereby rendering these claims obvious. Applicants respectfully disagree.

First, these claims are not obvious because the claims from which they depend are not obvious for the reasons discussed above. Second, Applicants reiterate the arguments from the 5/11/05 Response because Applicants believe they are still proper. In this connection, it is clear from the Examiner's comments that the Examiner misinterpreted Applicants' argument on page 16, paragraphs 5 and 6 and page 17, paragraph 1, of the 5/11/05 Response. In item 37, it appears that the Examiner believes that Applicants' argument was that Liddy et al. teach summing subject field codes, which are labels. This is not so. Applicants' prior argument is as follows. It clearly does not suggest that labels are summed.

In rejecting claims 55, 68, 80 and 93, the Examiner asserts that Liddy et al. disclose the “weights” limitation of these claims at col. 5, lines 10-11. The weights disclosed

at this passage are weights corresponding to subject fields codes, which are derived from summing occurrences of words for each subject field code. The subject code weights are contained in the subject code vector and are not summed. Rather, it is the word occurrences that are summed, as described at col. 9, lines 20-26. Applicants assert that the Examiner is improperly applying the word summation techniques described at col. 9, lines 20-26 to the weights disclosed at col. 5, lines 10-11. Applicants believe that these two passages describe concepts that are separate and distinct from one another and, as such, cannot reasonably be combined as the Examiner has done in rejecting these claims. Since neither the Liddy et al. patent nor Dunworth et al. patent disclose the weight tallying limitation of claims 57, 70, 82 and 95, the combination of these two patents cannot render these claims obvious.

5/11/05 Response, p. 16, ln. 28 to p. 17, ln. 10. Generally, this excerpt asserts that the Liddy et al. word summation techniques are not analogous to the assignment of weights as claimed in the rejected claims. Again, Applicants assert that the examining corps is simply picking and choosing disclosures that are, perhaps, somewhat related to concepts expressed in the claims. However, the rejection ignores the basic claim examining tenets of considering claimed invention as a whole and considering the contextual effect of the preamble.

Office Action Item 39

In item 39 of the present Office Action the Examiner states that Liddy et al. disclose the limitations of claims 52-54, 65-67, 77-79, and 90-92 that are directed to forming high level of abstraction clusters. Applicants respectfully disagree.

Again, the examining corps is picking and choosing unrelated concepts to reject a limitation parsed into phrases each containing something that resembles the concepts chosen. In the present case, it appears that the examining corps has merely conducted word searches and located terms used in the present claims. In the present case, the relevant portion of the Chen et al. patent states "The 'Clustering Report' 2410 contains the most characteristic keywords 2412 across all documents for the user cluster. This enables quick access to a high level abstraction of this modality while simultaneously viewing other properties." Chen et al. patent, col. 8, lines 13-17. How this teaches, e.g., the limitation of claim 52 of "forming a plurality of high level of abstraction (HLA) clusters and assigning each of said plurality of retrieved documents to one of said plurality of HLA clusters" is beyond comprehension of Applicants. The only reasonable

explanation is that the examining corps is ignoring certain tenets of claim examination discussed above.

Office Action Item 41

In item 41 of the present Office Action the Examiner essentially states that the rejection of claims 58, 60-62, 71-74, 83-86, 96, and 97 is not based on an improper hindsight combination of Dunworth et al., Liddy et al., and Bollay et al. Applicants respectfully disagree.

In addition to these claims being patentable because parent claims 50, 63, 75, and 87 are patentable for the reasons discussed above, the fact that the present rejection has been made based upon an improper parsing of claim limitations into component concepts without regard to the context of the parsed limitations and the claimed invention as a whole clearly counsels that the present rejection is based upon a level of hindsight reconstruction that far exceeds the acceptable level. Applicants are aware that a certain level of hindsight reconstruction is unavoidable in examining claims. However, when the reconstruction amounts to nothing more than a culling of out-of-context references, the amount of hindsight used is certainly improper.

Office Action Items 42 and 43

In items 42 and 43 of the present Office Action the Examiner essentially states that the Chen et al. and Bollay patents together teach the limitation of claim 59 of "populating said first input form with known documents already known to the user." Applicants respectfully disagree.

In support of the rejection, the Examiner states that Bollay teaches the populating of forms at col. 2, lines 51-54 and that Chen et al. teach use of known documents at col. 10, lines 21-24. Explicitly, Bollay states that "Local browser software populates a specific search form peculiar to a given remote database by utilizing the translations as embodied in JavaScript code," and Chen et al. state "It should be observed that in a presently preferred embodiment of the invention, the collection comprises all known documents that will ever be processed by a system according to the invention."

Again, Applicants assert that the examining corps has: 1) improperly parsed a claim limitation, i.e., "populating said first input form with known documents already known to the user," into components concepts, i.e., the concept of "populating an input form" and the concept of "known documents;" 2) located a reference for each of these concepts, i.e., the passages of the

Bollay and Chen et al. patents quoted above, wherein the context of these concepts in the cited patents is wholly unrelated to the claim limitation at issue; and 3) reconstructed these non-contextual, unrelated concepts into the claim limitation using an improper amount of hindsight of the present claim. Applicants assert that without the present claim, it is not reasonable to assert that a person having ordinary skill in the art would arrive at the claim limitation of "populating said first input form with known documents already known to the user" from a statement that a collection comprises all known documents and a statement that software populates a search form, especially when there is not motivation or even suggestion that the search form be populated with known documents.

Hunter et al./Lautzenheiser et al.

The Examiner has rejected claims 99 and 102 under 35 U.S.C. § 103 as being obvious in view of the Hunter et al. patent, discussed above, and further in view of U.S. Patent No. 6,728,693 to Lautzenheiser et al., stating Hunter et al. disclose a method and computer readable medium and containing all of the limitations of these claims except for conducting threat and opportunity analyses using problem-solved statements. The Examiner then asserts that Lautzenheiser et al. disclose the concepts of threat and opportunity analyses and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Lautzenheiser et al. in the method and computer readable medium disclosed by Hunter et al. Applicants respectfully disagree.

Lautzenheiser et al. disclose a method of implementing a database and system for handling customer survey data. The system includes features for conducting strength, weakness, opportunity, and threat (aka "SWOT") analyses on the survey data.

As discussed above, Hunter et al. disclose a system that aids inventors, technology managers, and patent professionals in preparing invention disclosures.

As also discussed above, Hunter et al. fail to disclose or suggest, among others, the steps of claims 99 and 102 of reviewing a plurality of documents and preparing a problem solved statement for each of the documents in the context of analyzing the documents. Lautzenheiser et al. are likewise completely silent on such steps. Therefore, the applied combination cannot render claims 99 and 102 obvious.

In addition, it is clear that the Examiner is using an improper amount of hindsight to make the present rejection. This is so because the overall teachings of the two patents are so different from each other that there is no reasonable motivation to combine the two. That is, it is unreasonable to say that SWOT features of Lautzenheiser et al. are combinable with the disclosure-drafting aid of Hunter et al., without using the present claims to construct a rejection.

Hunter et al./Lautzenheiser et al.

The Examiner has rejected claims 100 and 103 under 35 U.S.C. § 103 as being obvious in view of the Hunter et al. and Lautzenheiser et al. patents, discussed above, and further in view of U.S. Patent No. 6,154,720 to Onishi et al., stating Hunter et al. and Lautzenheiser et al. disclose a method and computer readable medium and containing all of the limitations of these claims except for associating weights with problem-solved statements. The Examiner then asserts that Onishi et al. disclose the concepts of threat and opportunity analyses and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Onishi et al. in the method and computer readable medium disclosed by Hunter et al. and Lautzenheiser et al. Applicants respectfully disagree.

The Hunter et al. and Lautzenheiser et al. patents are as described above.

The Onishi et al. patent is directed to a language translation apparatus for translating sentences from one language into another. In one embodiment, a weight is added to each of the semantic features registered for the individual conversational sentence examples in the bilingual database, and the semantic searcher determines the degree of semantic coincidence by using the weights.

None of the applied references discloses or even suggest the steps of reviewing a plurality of documents and preparing a problem solved statement for each of the documents in the context of analyzing the documents. Therefore, the applied combination cannot render claims 100 and 103 obvious.

Furthermore, the present rejection is clearly made using an improper amount of hindsight reconstruction of the claims. Again, the rejection includes snippets from disparate and unrelated references that are combined ad hoc so as to reject the claims. In summary, none of the references cited by the Examiner disclose or suggest the combination of elements present in the

claims under consideration. The only motivation for the combination is pure hindsight of the claims.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw all of the rejections made under 35 U.S.C. § 103.

Conclusion

In view of the foregoing, Applicants respectfully submit that claims 50-103, as previously amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,
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